

REMARKS/ARGUMENTS

Claim 1 is present in this application.

Claim 1 was rejected under 35 U.S.C. §103(a) over U.S. Patent No. 5,199,937 or Japanese Patent Publication 030-080954 to Wada et al. in view of U.S. Patent No. 5,681,530 to Kuster et al. This rejection is respectfully traversed.

The Office Action recognizes that Wada lacks at least the claimed rotating disc having slots closed at radial outermost ends thereof such that the rotating disc comprises a continuous circumference. The Office Action contends, however, that it would have been obvious to modify the Wada structure to close the radial outermost ends of the slots in view of the Kuster patent. Applicant respectfully submits, however, that this contention is misplaced.

It is well settled that “obviousness cannot be established by combining the teaching of the prior art to meet the product of the claimed invention, absent some teaching or suggestion supporting the combination. Under §103, teachings of references can be combined only if there is some suggestion or incentive to do so.” *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 221 USPQ 929 (Fed. Cir. 1984). Moreover, “the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992). The Office Action contends that it would be desirable to close the slot ends in the Wada apparatus “to ensure that the buckets held by the slots do not slip or fall out of the slots during centrifugation or rotation of the rotor.” Simply closing the slot ends, however, would not achieve this function. If the buckets were inclined to “slip or fall out of the slots during centrifugation,” slots with closed ends would fail to prevent this. As such, Applicant submits that there is no suggestion in either reference to support the alleged combination. In addition, nowhere does the Wada patent suggest

that slipping buckets is a particular concern, and nowhere does Kuster suggest that its closed slots provide such functionality. Consequently, Applicant submits that neither reference suggests the desirability of the modification.

Moreover, it is clear from the Wada structure that closing the slots would interfere with the radial and outward swing of the bucket 3 during rotation of the rotor 1, particularly if the slots were closed to an extent that they could even remotely “ensure that the buckets held by the slots do not slip or fall out of the slots during centrifugation or rotation of the rotor.” Closing of the slots would thus render the Wada apparatus inoperative for its intended purpose. In this context, see *Hughes Aircraft Co. v United States*, 215 USPQ 787, 804 (Ct. Cl. 1982), *relevant portions aff’d*, 219 USPQ 473 (Fed. Cir. 1983), wherein the Court held that “it is generally settled that a change in a prior art device which makes the device inoperable for its intended purpose cannot be considered to be an obvious change.”

The Kuster patent describes a cassette centrifuge 40 that includes slots 42 for receiving blood sample cassettes. The openings or slots in the storage unit 12 for receiving and storing the cassettes 100 are adapted to maintain the cassettes in an upright condition, as shown in Fig. 6 (see column 5, lines 8-10). The slots 42 are thus closed at their radial outermost ends to maintain the cassettes 100 in an upright condition. The cassettes in the Kuster apparatus, however, do not in any manner swing radially and outwardly by centrifugal force during operation of the centrifuge 40. As such, the Kuster patent lacks any suggestion to modify the Wada structure to include closed end slots.

As a consequence, Applicant respectfully submits that the rejection is misplaced. Reconsideration and withdrawal of the rejection are respectfully requested.

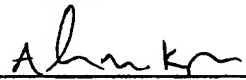
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In view of the foregoing remarks, Applicant respectfully submits that the claims are patentable over the art of record and that the application is in condition for allowance. Should the Examiner believe that anything further is desirable in order to place the application in condition for allowance, the Examiner is invited to contact Applicant's undersigned attorney at the telephone number listed below.

Prompt passage to issuance is earnestly solicited.

Respectfully submitted,

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